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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/715,469

11/17/2000

Philip Smith Becker JR.

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06/08/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT

PAPER NUMBER

2134

2

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,469

Applicant(s)

BECKER ET AL.

Examiner

Michael J Simitoski

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4,10-14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


NORMAN M. WRIGHT
PRIMARY EXAMINER

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-17 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The claim is unclear as to which “information” is being referred to in lines 11 and 12. The examiner suggests the following changes: “validating the received key sequence information” could be replaced with “validating the received entered key sequence information” and “comparing the received information” with “comparing the entered received key sequence information”. *For the purposes of this Office Action, the claim is interpreted as stated in the above changes.*

- b. The claim is also unclear in line 4 where the limitation “receiving ... number entered by a user at said remote computer” suggests that the user enters the personal identification number at the remote computer. A suggested clarification is the following: “receiving ... a user-entered assigned personal ... at said remote”.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5-7 & 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,014,815 to Alcorn et al. (Alcorn) in view of "When a password is not a password" by Weiss, in further view of U.S. Patent 4,916,443 to Barrett et al. (Barrett).

Regarding claim 1, Alcorn discloses a GPS circuit to generate signals representing a geographic location (col. 5, lines 1-15), means/serial cable and computer for connecting the system to a network/Internet (col. 4, line 55 – col. 5, line 15), means for connecting a system to a local computer coupled to said network/Internet (col. 4, lines 55-67), a keypad having a plurality of keys (Fig. 1, #20) and logic means for communicating with a remote host computer coupled to said network and with said local computer (Fig. 1, #14) and sending an entered key sequence/PIN (col. 7, lines 1-7 & Fig. 3), a serial number/identifier (col. 10, lines 8-10) and geographic/position information provided by said GPS circuit to said host computer (col. 7, lines 1-7). Alcorn lacks receiving key sequence information from said remote host computer and determining if an attempt has been made to enter a key sequence using said keypad within a predetermined period of time, and if yes, sending the data. However, Weiss teaches that to securely authenticate a user and prove he or she possesses a discrete token, the user can enter a PIN to the token, and enter a user ID and password into a terminal. The terminal generates a challenge, which is communicated to the token; the token generates a response that is then communicated to the terminal to be checked (page 107, §*Challenge-Response*). Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to receive key sequence information/challenge from said remote host computer. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate a user and ensure the user is in possession of the particular token/verification system, as taught by Weiss (page 107, §*Challenge-Response*). Barrett teaches that when entering a password in a device, the device can have a timeout period where if no password is entered, the device is deenergized, going into sleep mode (col. 8, lines 50-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine if the sequence was entered within a predetermined period of time. One of ordinary skill in the art would have been motivated to perform such a modification to allow the device to enter sleep mode (saving energy), as taught by Barrett (col. 8, lines 50-65).

Regarding claim 3, the method claim is substantially equivalent to system claim 1 and is therefore rejected under similar rationale.

Regarding claim 5, Alcorn discloses communicating with GPS satellites (col. 5, lines 1-15) and generating a latitude and longitude of the GPS circuit using signals received from said satellites (col. 7, lines 1-7 & col. 5, lines 16-25).

Regarding claims 6 & 7, Alcorn discloses a serial port connecting the system to a computer and network (col. 4, lines 56-67).

Regarding claim 9, Alcorn discloses an operating program for the microprocessor (col. 9, lines 1-5).

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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alcorn in view of Weiss and Barrett, as applied to claim 1, in further view of U.S. Patent 5,711,588 to Rudisill. Alcorn, as modified above, lacks each of the plurality of keys comprising at least one LED. However, Rudisill teaches that it is desirable to provide backlighting of keypads on devices, using LEDs (col. 1, lines 10-13). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have each key comprise at least one LED. One of ordinary skill in the art would have been motivated to perform such a modification because it is often desirable to do so, as taught by Rudisill (col. 1, lines 10-13).

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alcorn in view of Weiss and Barrett, as applied to claim 3, in further view of U.S. Patent 6,507,852 to Dempsey et al. (Dempsey). Alcorn, as modified above, lacks sending a message indicating the key sequence was not entered within a predetermined amount of time. However, Dempsey teaches that event logs are kept to detect that a system is behaving in a manner requiring the attention of an administrator (col. 1, lines 24-33). Since the host is expecting a GPS signal with a PIN, etc., if the PIN is not received, it could be an indication that administrator attention is required. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send a message indicating the key sequence/PIN was not entered within a predetermined amount of time. One of ordinary skill in the art would have been motivated to perform such a modification to determine if the device or user is behaving in a manner requiring administrator attention, as taught by Dempsey (col. 1, lines 24-33).

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8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss in view of Alcorn. Weiss discloses communicating with a remote computer/host (via terminal) coupled to a network and with a verification system/security token coupled to said remote computer/host, receiving a personal identification number/password entered by a user at said remote computer/host and verifying the received personal identification number is valid/correct, if the received personal identification number/password is valid/correct, transmitting key sequence information/challenge to said remote computer/host/terminal and said verification system/security token, receiving entered key sequence information/response generated by said verification system/security token and validating the received entered key sequence information/response by comparing the received entered key sequence information with expected key sequence information (pages 107-108, §*Challenge-Response*). Weiss lacks also receiving a serial number and geographic information and validating the serial number and geographic information. However, Alcorn teaches a system where a gambling player is authenticated using a geographic location (col. 3, lines 53-64) and a serial number/identifier (col. 10, lines 8-10) and upon authentication, a wager is accepted from the player (Fig. 7c). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the authentication method, taught by Weiss, with the gaming system of Alcorn, and hence receive and validate key sequence information, serial number and geographic information to allow acceptance of a wager. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate a user for online gambling, as taught by Alcorn (col. 3, lines 53-64, col. 10, lines 8-10 & Fig. 7c).

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Allowable Subject Matter

9. Claims 2, 4, 10-14 & 16 are allowed.
10. The following is a statement of reasons for the indication of allowable subject matter: the prior art relied upon fails to teach or suggest changing a color or symbol associated with each of the keys on a keypad based on a received key sequence after a key has been depressed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. The '147 & '307 Patent references are cited for teaching the requirement that a password be entered within a specific predetermined period of time.
- b. The '638 reference and JPO 2002-101091 are cited for teaching GPS (position-based) authentication and verification.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (703)305-8191. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. - 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703)308-4789.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

(703)746-7239 (for formal communications intended for entry)

Or:


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(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MJS
May 17, 2004


NORMAN M. WRIGHT
PRIMARY EXAMINER